



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/313,131	05/17/99	STEINBERG	E 4473-27

DAVID H JAFFER ESQ
ROSENBLUM PARISH AND ISAACS
160 WEST SANTA CLARA STREET 15TH FLOOR
SAN JOSE CA 95113

TM11/1013

EXAMINER

CHRISTENSEN, A

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 10/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/313,131

Applicant(s)
Steinberg

Examiner
Andy Christensen

Group Art Unit
2612



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-52 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-52 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2,3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. The Applicant is hereby notified that the Examiner's Art Unit has been changed from 2712 to 2612.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said automatic signal transmission means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis

for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1, 5-8, 11, 12, 15 and 16 are rejected under 35 USC 102(e) as being anticipated by Yuyama et al. (U.S. Patent No. 5,825,408).

Regarding Claim 1, Yuyama et al. disclose a digital camera comprising a means for

converting a light image to digital image data (Figure 10), a transceiver means (208) for sending and receiving digital data through a communication network, and a code means for selectively receiving messages sent to the camera by a message center (Column 16, Lines 55-65).

Regarding Claim 5, Yuyama et al. disclose that the code means includes a unique identification for the camera (Column 17, Lines 36-37).

Regarding Claim 6, Yuyama et al. disclose a display means for displaying the messages and a means for displaying the image (205).

Regarding Claim 7, Yuyama et al. disclose that the display is an LCD display located on a back side of the camera (Column 17, Line 56; Figure 5).

Regarding Claim 8, Yuyama et al. disclose that the display means includes a dedicated banner region for display of the messages (Column 17, Lines 56-57; the display region is interpreted to be a banner region specifically dedicated for the display of the received message).

Regarding Claim 11, Yuyama et al. disclose an interactive message response means for responding to a question received in a message from the message center (inherent in the ability of the fax operation to respond to received information).

Regarding Claim 12, Yuyama et al. disclose that the interactive message response means enables a user to selectively store, delete and skip a message (Column 10, Lines 55-59).

Regarding Claim 15, Yuyama et al. disclose an audio means in the form of a speaker (307) for playing the messages on the digital camera.

Regarding Claim 16, Yuyama et al. disclose that the messages can be interactively replayed, stored and skipped (Column 10, Lines 55-59).

4. Claims 1-6, 8, 11, 15, 17-26, 28-30, 33-40, 42-43 and 46-50 are rejected under 35 USC 102(e) as being anticipated by Ilcisin et al. (U.S. Patent No. 5,880,770).

Regarding Claim 1, Ilcisin et al. disclose a digital camera comprising a means for converting a light image to digital image data (22), a transceiver means for sending and receiving digital data through a communication network (Column 4, Lines 47-50), and a code means for selectively receiving messages sent to the camera by a message center (See Column 8, Lines 3-7 and note that each camera has a code in the form of its phone number or TCP/IP address).

Regarding Claim 2, Ilcisin et al. disclose an automatic signal transmission means for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on (See Column 2, Lines 49-

56 and note that the camera's identification is inherently provided since it is sent message information in response to its call).

Regarding Claim 3, Ilcisin et al. disclose a user activated means for causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera (See Column 2, Lines 49-56 and Examiner's comments regarding Claim 2 and note that the call is user initiated).

Regarding Claim 4, Ilcisin et al. disclose a means for disabling an automatic signal transmission means when a user does not want to receive messages (See Column 3, Lines 65-67 and note that longer-time-period messages may not be acceptable).

Regarding Claim 5, Ilcisin et al. disclose that the code means includes a unique identification for the camera (See Column 8, Lines 3-7 and note that each camera has a unique identification the form of its phone number or TCP/IP address).

Regarding Claim 6, Ilcisin et al. disclose a display means (20) for displaying the messages and the image (Column 2, Lines 50-53).

Regarding Claim 8, Ilcisin et al. disclose that the display means includes a dedicated

banner region for display of the messages (Column 2, Lines 50-53).

Regarding Claim 11, Ilcisin et al. disclose an interactive message response means for responding to a question received in a message from the message center (Column 7, Lines 40-45).

Regarding Claim 15, Ilcisin et al. disclose an audio means in the form of a speaker (24) for playing the messages on the digital camera.

Regarding Claim 17, Ilcisin et al. disclose a digital camera message system comprising a message center means including a means for collecting, preparing and sorting messages to be sent to a digital camera (Column 2, Line 49 - Column 3, Line 33; Column 8, Lines 13-35) and a first communication means responsive to reception of a message request signal conveying a camera identification for transmitting messages to the camera (See Column 2, Lines 49-56 and note that the calling device's identification is inherently provided since it is sent message information in response to its call); and a digital camera including an image capture means (22), second communication means (Column 4, Lines 47-50); code means (See Column 8, Lines 3-7 and note that each camera has a code in the form of its phone number or TCP/IP address) and automatic signal transmission means (See Column 2, Lines 49-56 and note that the camera's identification is inherently provided since it is sent message information in response to its call).

Regarding Claim 18, Ilcisin et al. disclose that the message center means includes a capability to send a selected message to a specific camera based on the code (Column 2, Lines 49-52).

Regarding Claim 19, Ilcisin et al. disclose that the message center means further includes a capability to send a message simultaneously to a plurality of cameras by transmitting a corresponding particular code (Column 8, Lines 13-35).

Regarding Claim 20, Ilcisin et al. disclose that the message center means further includes a capability to prioritize messages as part of a single packet of multiple messages (Column 8, Lines 13-35).

Regarding Claim 21, Ilcisin et al. disclose that the digital camera further includes means for disabling the automatic signal transmission means (Column 1, Lines 60-61).

Regarding Claim 22, Ilcisin et al. disclose that the camera further includes a message display means (20).

Regarding Claim 23, it is inherent in Ilcisin et al. that the messages be stored prior to display since they must be stored in order to be continuously displayed (Column 2, Lines 59-61).

Regarding Claim 24, Ilcisin et al. disclose that the camera further includes means for selecting a particular one of the stored messages (See Column 2, Lines 59-62 and note that the first stored message is clearly selected to be displayed first).

Regarding Claim 25, Ilcisin et al. disclose that the means for selecting includes setting the camera to automatically display a list of stored messages sequentially with each message displayed for a set amount of time (Column 2, Lines 59-62).

Regarding Claim 26, Ilcisin et al. disclose that the means for selecting includes a means for automatically displaying the messages in an order according to a priority assigned by the message center (Column 2, Lines 59-62; Column 8, Lines 13-35).

Regarding Claim 28, Ilcisin et al. disclose that the message display means is viewed through a viewfinder (20) of the camera.

Regarding Claim 29, Ilcisin et al. disclose that the message display means is generated through a speaker located on the camera (Column 9, Lines 57-60).

Regarding Claim 30, Ilcisin et al. disclose an interactive message response means for responding to a question received in a message from the message center (Column 7, Lines 40-45).

As to Claim 33, see Examiner's comments regarding Claims 17 and 22.

Regarding Claim 34, Ilcisin et al. disclose a means for preparing multiple messages to be transmitted and assigning priority values to the messages (Column 2, Line 59 - Column 3, Line 5; Column 8, Lines 13-35).

Regarding Claim 35, Ilcisin et al. disclose that the priority values include a length of time to display each message (Column 2, Lines 59 - Column 3, Line 7).

Regarding Claim 36, Ilcisin et al. disclose that the priority values include an order of display of the messages (Column 8, Lines 13-35).

Regarding Claim 37, Ilcisin et al. disclose disabling the transceiver means to avoid transmitting the message request (Column 1, Lines 60-61).

Regarding Claim 38, Ilcisin et al. disclose that the display means includes a dedicated banner region for display of the messages (Column 2, Line 51-53).

Regarding Claims 39-40, Ilcisin et al. disclose that the display means includes a separate dedicated display means (20) for display of the messages, the display being a viewfinder of the

camera.

Regarding Claim 42, Ilcisin et al. disclose that the display means includes a speaker (24) located on the camera.

As to Claim 43, see Examiner's comments regarding Claim 30.

Regarding Claim 46, Ilcisin et al. disclose a digital camera message system comprising a message center means including a means for collecting, preparing and sorting messages to be sent to a digital camera, the messages including a generic message for transmission to all of a plurality of cameras, and interest group based message for transmission to selected cameras of a particular interest group, a personal message prepared for transmission to a selected one of the cameras and a means for transmission of the messages to the cameras including a means for repeatedly transmitting the messages and a means for including a code and each personal message to be received only by a corresponding selected camera (Column 3, Lines 2-25; Column 8, Lines 13-35).

Regarding Claim 47, Ilcisin et al. disclose a means for continuously sending the messages (Column 3, Lines 2-12).

Regarding Claim 48, Ilcisin et al. disclose a means for unselectively sending the messages (Column 3, Lines 13-14; Column 8, Lines 20-35).

Regarding Claim 49, Ilcisin et al. disclose a means for sending the messages only when a request arrives from the digital camera (Column 1, Lines 60-61; Column 2, Lines 49-52).

Regarding Claim 50, Ilcisin et al. disclose a digital camera including an image capture means (32), communication means (Column 4, Lines 47-50), code means (See Column 8, Lines 3-7 and note that each camera has a code in the form of its phone number or TCP/IP address), and disabling means (See Column 3, Lines 65-67 and note that longer-time-period messages may not be acceptable).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 USC 103(a) as being unpatentable over King (U.S. Patent No. 5,220,366).

King discloses a camera comprising an image capture means (10), transceiver means (32,

52) and code means (Column 2, Lines 59-63). Although the King device may be a video camera (Column 3, Lines 48-49) there is not a specific disclosure that the image data is digital. However Official Notice is given that it is well known in the art to configure a video camera as a digital camera in order to enable digital signal processing and image storage. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to form the King video camera in a digital version in order to facilitate digital signal processing and image storage. King also does not disclose that data sent and received is in digital format. However Official Notice is also given that it is well known in the art to configure a communications network so as to send and receive data in a digital format, again to facilitate digital signal processing and data storage. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the communications network in King so as to send and receive data in a digital format in order to facilitate digital signal processing and data storage.

6. Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Yuyama et al.

Yuyama et al. disclose transmitting a message request signal when transmission of a message is desired (Column 17, Lines 36-42) but do not disclose that the transceiver issues the request. However it is clear that either party in a message transmission system such as Yuyama et al. may initiate such a request. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the Yuyama et al. arrangement so as to cause the transceiver to transmit the message request signal to the message center, such clearly being an

obvious variation of Yuyama et al. In such an arrangement it would have been obvious to convey the camera's identification in order to enable it to be sent the requested message.

7. Claims 2, 4 are rejected under 35 USC 103(a) as being unpatentable over Yuyama et al. in view of Ilcisin et al.

Regarding Claim 2, Yuyama et al. disclose all of the limitations except an automatic signal transmission means for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on. However it is well known in the art to operate a videophone system in such a manner, as disclosed in Ilcisin et al. in order to make sure that necessary messages are received by the person initiating the call (Column 2, Line 49 - Column 3, Lines 12). Such a provision for the Yuyama et al. device would clearly increase its utility by increasing the kinds of information made available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Yuyama et al. device an automatic signal transmission means for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user.

Regarding Claim 4, Yuyama et al. disclose all of the limitations except an automatic signal

transmission means that is disabled when a user does not want to receive messages. However it is well known in the art to operate a videophone system so as to send messages automatically, as disclosed in Ilcisin et al. in order to make sure that necessary messages are received by the person initiating the call (Column 2, Line 49 - Column 3, Lines 12). Such a provision for the Yuyama et al. device would clearly increase its utility by increasing the kinds of information made available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Yuyama et al. device an automatic signal transmission means for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user. In Ilcisin et al. this feature may be disabled when the user does not want to receive messages (See Column 3, Lines 65-67 and note that longer-time-period messages may not be acceptable).

8. Claims 9-10 are rejected under 35 USC 103(a) as being unpatentable over Yuyama et al. in view of Ishimaru et al. (U.S. Patent No. 5,003,399)

Regarding Claims 9 and 10, Yuyama et al. disclose all of the limitations except for a second display observable through a viewfinder. However it is very well known in the art to provide a camera with a viewfinder so as to assist the user in aiming of the camera and framing of the object of interest. Ishimaru et al. disclose such a provision (See Figure 1; Item 14). It would

have been obvious to one of ordinary skill in the art at the time of the invention to provide a viewfinder in the Yuyama et al. camera to assist the user in properly aiming the camera and framing the object of interest. Furthermore, messages can be displayed on the viewfinder in Ishimaru et al. (Column 11, Lines 7-9). Messages viewed through a viewfinder are clearly more easily seen than those displayed on an external display under high ambient light conditions since the user's eye is able to block ambient light while looking into the viewfinder. Therefore it would have been obvious to enable the messages of Yuyama et al. and Ishimaru et al. to be displayed in the viewfinder so that they would become more visible during high ambient light conditions.

9. Claims 13-14 are rejected under 35 USC 103(a) as being unpatentable over Yuyama et al. in view of Wilska et al. (GB 2,289,555).

Regarding Claims 13 and 14, Yuyama et al. do not disclose including a touch screen with the first display or buttons whereby the interactive response means is activated. However it is well known in the art to incorporate these features into a camera device for the purpose of interactive message response as part of a personal communication operation, as disclosed in Wilska et al (Page 12, fourth paragraph). Inclusion of these features in Yuyama et al. would clearly increase the utility of the device by enabling a greater variety of information to be communicated thereby. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include in Yuyama et al. a touch screen with the first display or buttons whereby the interactive response means is activated in order to increase the variety of communication modes

available with the device.

10. Claims 27 and 41 are rejected under 35 USC 103(a) as being unpatentable over Ilcisin et al.

Regarding Claims 27 and 41, Ilcisin et al. do not give details regarding the design of the display and thus do not describe it as a LCD located on the back side of the camera. However Official Notice is given that it is well know in the art to use a LCD as a display in order to reduce the size and power consumption of a display device. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the Ilcisin et al. display as a LCD device in order to minimize its size and power consumption. Furthermore it is clear that either side of the Ilcisin et al. device may be defined as the back side, and therefore locating the display on the back side would clearly have been an obvious variation in the design of the device.

11. Claims 31-32 and 44-45 are rejected under 35 USC 103(a) as being unpatentable over Ilcisin et al. in view of Wilska et al.

Regarding Claims 31-32 and 44-45, Ilcisin et al. do not disclose including a touch screen with the first display or buttons whereby the interactive response means is activated. However it is well known in the art to incorporate these features into a camera device for the purpose of interactive message response as part of a personal communication operation, as disclosed in Wilska et al (Page 12, fourth paragraph). Inclusion of these features in Ilcisin et al. would clearly

increase the utility of the device by enabling a greater variety of information to be communicated thereby. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include in Ilcisin et al. a touch screen with the first display or buttons whereby the interactive response means is activated in order to increase the variety of communication modes available with the device.

12. Claims 51-52 are rejected under 35 USC 103(a) as being unpatentable over Ilcisin et al. in view of Davidsohn et al. (U.S. Patent No, 5,606,361).

Regarding Claim 51 and 52, Ilcisin et al. do not disclose that the personal messages are encrypted with the camera comprising a means for decrypting the messages. However it is well known in the art to encrypt a sent message, with the receiving unit having a decrypting means enabling the reading of the message, as disclosed in Davidsohn et al. (See Abstract and Figure 1), such a provision enabling the information in a message to be safeguarded when desired. Provision of this capability in Ilcisin et al. would clearly increase its utility by adding a security mode of communication well known in the art to be beneficial for the sending of certain personal messages that are desired to be private. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt the messages of Ilcisin et al. and provide the camera with a means for decrypting the messages in order to enable certain of the messages to be privately communicated.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-6306 (for informal or draft communications; please label "PROPOSED" or "DRAFT").

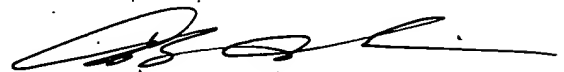
Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

14. Any inquiry regarding this communication or earlier communications from the examiner should be directed to Andy Christensen whose telephone number is (703) 308-9644.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Wendy Garber, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

ac
October 4, 2000



**ANDREW CHRISTENSEN
PATENT EXAMINER**